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In re Application of	:	
GRAY	:	DECISION ON
Application No.: 09/486,183	:	
PCT No.: PCT/GB00/00286	:	PETITION
Int. Filing Date: 02 February 2000	:	
Priority Date: 08 February 1999	:	UNDER 37 CFR 1.181
Attorney's Docket No.: 540-186	:	
For: FIBRE REINFORCED COMPOSITES AND	:	
METHODS OF MAKING SAME	:	

This is in response to the petition under 37 CFR 1.181, filed 26 February 2003, requesting examination on claims 1-13 as original filed in the above-identified international application.

BACKGROUND

On 02 February 2000, applicant filed international application PCT/GB00/00286, which claimed priority of an earlier British application filed 08 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 August 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 08 August 2001.

On 23 February 2000, applicant filed with the United States Patent and Trademark Office (USPTO) a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application as required by 35 U.S.C. 371(c)(2); and a declaration as required by 35 U.S.C. 371(c)(4).

On 13 July 2000, applicants filed a Status Inquiry with the United States Patent and Trademark Office requesting when an Official Filing Receipt would be issued.

On 19 August 2000, applicant filed a Demand for international preliminary examination with the European Patent Office.

On 26 January 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors had not been filed. The notification set a one-month time limit in which to respond.

On 07 February 2001, applicant filed a response to the Notification of Missing Requirements indicating that the declaration had been filed on 23 February 2000.

On 12 February 2001, applicant filed amendments to the international application under PCT Article 34 with the European Patent Office amending the description and the claims. The claims were amended from claims 1-13 to claims 1-11.

On 09 May 2001, the European Patent Office established an international preliminary examination report (IPER) on claims 1-11 and attached to the IPER, the amended sheets as annexes.

On 11 September 2001, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) indicating the annexes to the IPER had been entered. On 21 September 2001, the USPTO mailed an Official Filing Receipt indicating the application contains a total of 13 claims.

On 20 May 2002, the USPTO mailed a first Office action based on an examination of the claims contained in the annexes, i.e. claims 1-11.

On 20 November 2002, applicant filed a response to the first Office action indicating that the Office action did not act on claims 1-13.

On 18 December 2002, the USPTO issued a final office action on claims 1-11 indicating that the claims 1-11 were properly before the examiner for examination.

On 26 February 2002, applicant filed the present petition asking for the original claims 1-13 to be examined.

DISCUSSION

Applicant has filed the present petition under 37 CFR 1.181. Paragraph (f) of 37 CFR 1.181 states in part,

"Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided."

The Notice of Acceptance indicating that the annexes to the IPER were entered was mailed on 11 September 2001. Applicant did not question the entry of the annexes until 20 November 2002. Accordingly, the petition is dismissed as being untimely.

Applicant stated that he was relying on the Official Filing Receipt which indicated that 13 claims were present in the application. Such reliance is misfounded. Amended claims 1-11 contains two proper multiple dependent claims; each claim being dependent on two previous claims. Thus, each of the two multiple dependent claims counts as two claims. They, are included in the claim count and thus the total number of claims present in amended claims 1-11 was correctly indicated as 13 claims. It is noted that original claims 1-13 also contained two proper multiple dependent claims; each claim being dependent on three previous claims. Thus, each of these two multiple dependent claims counts as three claims. Thus, if the original claims had been relied upon, the Official Filing Receipt would have indicated a total of 17 claims and not 13 claims as asserted by applicant. See MPEP 608.01(o).

Applicant did not file any papers indicating that the annexes to the IPER should not have been entered either with the transmittal letter filed on 23 February 2000 or in response to the Notification of Acceptance mailed on 11 September 2001.

Amendments submitted during the international stage of an international application are considered to be a part of the national stage application unless considered cancelled. See 35 U.S.C. 371(d) which states in part,

"The requirements of subsection (c)(3) of this section shall be complied with by the date of the commencement of the national stage, and failure to do so shall be regarded as a cancellation of the amendments to the claims in the international application made under article 19 of the treaty. The requirement of subsection (c)(5) shall be complied with at such time as may be fixed by the Director and failure to do so shall be regarded as cancellation of the amendments made under article 34(2)(b) of the treaty."

Thus, the amendments made during the international stage are considered to be a part of the national stage application, in the absence of instructions by the applicant. Therefore the Notice of Acceptance correctly indicated that the annexes were entered and the subsequent office actions correctly examined claims 1-11. Accordingly, applicants petition is dismissed.

CONCLUSION

The petition under 37 CFR 1.181 is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required.

No extensions of time may be obtained under 37 CFR 1.136

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, PCT Legal Office, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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